



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Richard A. BELANGER

Serial No.: 10/538,325

Filed: June 10, 2005

For: HOT MELT DISPENSER WITH SILICONE VALVE

REQUEST TO WITHDRAW FINAL STATUS OF OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests the USPTO to withdraw the final status of the Office Action dated December 10, 2007.

Pursuant to MPEP §706.07(a), a second action on the merits should not be made final "if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed." That section refers to MPEP §904, which provides that "the first search should cover the invention as described and claimed, including the inventive concepts toward which the claims appear to be directed."

It is submitted that comparison of the first Office Action with the outstanding (final) Office Action reveals that the amendment of September 20, 2007, did not necessitate the rejection over the newly cited reference to Flier. That is, the first Office Action pointed out where the initially cited Gordon reference showed a valve having a

central portion with a front wall displaced from an annular portion, where the annular portion is recessed and the valve further includes a marginal edge. The outstanding Office Action points to these very same features as being found in the newly asserted Flier reference, namely, a valve, front and back walls, a central section, a recessed annular section, and a marginal edge.

Thus, there is no significant difference between the features pointed to in the first Office Action and those pointed to in the outstanding Office Action. Accordingly, application of the Flier reference was evidently not necessitated by any amendment to the claims. It is submitted in that regard that the amendment merely clarified the claimed limitations without substantially changing the claimed subject matter.

A still further indication that the amendments did not “necessitate” the citation of Flier is the reference in the first full paragraph of page 3 of the outstanding Office Action to the “Gordon-Brown combination.” It appears that the examiner simply decided that Flier is a better reference and substituted it outright for the Gordon reference without regard to the amendments.

Moreover, and perhaps more telling, is the fact that the PTO apparently failed to fulfill its mandate to conduct a search of the invention as claimed and disclosed (MPEP §904). A review of the Search Notes reveals that the examiner’s initial search conducted on June 9, 2007, included class 222, subclass 490, which contains the Flier reference. The Flier reference does not appear to be classified in the areas searched by the examiner after the amendment. Thus, the failure to cite the Flier reference in the first Office Action was simply an oversight on the part of the PTO, not a direct result of the amendments to the claims.

For the above reasons, the PTO is respectfully requested to withdraw the final status of the outstanding Office Action.

Applicant believes there is no fee required for this submission, however, please charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088.

Respectfully submitted,
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